

### R E M A R K S

Claims 1-25 and 30-39 are in the case. Favorable action thereon is requested. The Examiner made a restriction requirement between the inventions of Group I (Claims 1-25, drawn to a method) and the inventions of Group II (Claims 26-29, drawn to a recreational body of water) during a telephone conversation with the undersigned on July 28, 2003. The inventions of Group I, claims 1-25, were provisionally elected with traverse. As required, Applicant hereby affirms the election of the inventions of Group I (Claims 1-25), without prejudice. Claims 26-29 are cancelled without prejudice or disclaimer. New Claims 30-39 are drawn to a method for enabling uniform control of bromine concentrations in a recreational body of water. Only six(6) of the newly added claims require additional fees, since Claims 26-29 have been cancelled without prejudice or disclaimer. Support for new Claims 30-33 can be found at least in the Specification at page 4, paragraph 9, where it is stated that "ORP bounce describes a condition where, for the same active bromine residual quantity in the water, different (usually lowered) ORP responses are detected." Additional support for these claims can also be found beginning at page 4 of the Specification which states at paragraph 10, "When a body of water has been initially treated with N,N'-dihalo-5,5-dialkylhydantoin, it has been observed that, though the independent DPD test yields a steady value of bromine, the ORP mV reading is inconsistent." Also, support for new Claims 30-33 can be found at least at: page 6, paragraph 17; page 7, paragraph 21; page 11, paragraph 32 and page 12, paragraph 33 of the Specification. Additional support for Claims 31 and 32 can be found in Claims 5 and 7 as originally filed and at page 8, paragraph 24 and page 9, paragraph 26 of the Specification. Support at least for new Claim 33 can be found at page 6, paragraph 16 and page 7, paragraph 20 of the Specification. Support for new Claim 34 can be found at page 2, paragraph 3, page 7, paragraph 23 and page 8, paragraph 24 of the Specification and in original Claims 2, 4 and 5. Support for new Claim 35 can be found at page 8, paragraph 25, page 9, paragraph 26 of the Specification and in original Claims 6 and 7. Support for new Claim 36 can be found at page 10, paragraph 28 of the Specification and in original Claim 8. Support for new Claim 37 can be found at page 11, paragraph 30 of the Specification and in original Claim 9. Support for new Claims 38 and 39 can be found at page

7, paragraph 22 of the Specification and in original Claims 19 and 20. No new matter is added by new Claims 30-39.

The 103(a) rejection of Claims 1-25, based on Sanders et al. ("Sanders") (US Pat. No. 6,303,038 B1) in view of Martin et al. ("Martin") (US Pat. No. 6,149,819) and Theyson ("Theyson") (US Pat. No. 4,698,165) is respectfully traversed.

As made clear in the Office Action, the rejection depends upon all three of the references, Sanders, Martin and Theyson. Yet on inspection of these references, it is seen that they deal with differing technologies which are inconsistent in their attempted combination. These references contain irreconcilable conflicts among their teachings. First, Sanders requires use of dialkylhydantoin and source of bromide ion, both at low concentration. (Sanders, Column 2, lines 47-58.) However, Sanders teaches away from use of halogenated hydantoins at Column 1, lines 57-62:

The sanitization methods described herein function in bodies of water with conditions corresponding to chlorine lock, **do not expose human handlers to halogenated hydantoins**, and stabilize biocidal bromine species for periods of weeks.

(Emphasis supplied.)

In sharp contrast, Martin teaches that hydantoin based bromines can be used as a primary oxidizer. (Martin, Column 4, lines 22-28.) Therefore to the extent that Martin has any relevance it is in direct conflict with Sanders, who does not want to feed halogenated hydantoin.

On the other hand, whereas Sanders uses DMH as a component, and Martin includes hydantoin based bromines as a primary oxidizer. Theyson teaches against addition of both halogenated 5,5-dialkyl hydantoins **and** DMH, since ring-opening reactions take place in both systems resulting in undesirable imine derivatives. (Theyson, Column 2, line 10- Column 3, line 62.) Furthermore, Theyson is concerned with solving problems dealing with shock treatment

of pools. (Theyson Column 4, lines 41-45.) Neither Sanders nor Martin deal with such shock treatments.

Another glaring difference between Sanders and Theyson concerns the use of low levels of oxidizer by Sanders, while Theyson, in his shock treatment, relies on high levels of oxidizer. (See Sanders at Tables 3 and 4, and Theyson at Column 4, lines 11-14 and Table I.)

Therefore combination of these three references is improper and untenable. It is well settled that it is impermissible to use hindsight to support a rejection under 35 U.S.C. 103. As stated by the Federal Circuit in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." [*In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992, quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)].

Even if one skilled in the art had come across these three references he would not have been motivated to combine them and certainly would have no motivation to select only certain of the features of each as suggested by the Office Action.

It is to be noted that a quick search of Applicants' internal records indicates that the present invention was conceived and duly diligent actions to prepare the present application were undertaken prior to the issuance of the Sanders et al. patent, a reference which shares a co-inventor and mutual assignee with the present application.

In view of the failure of the cited references to establish a *prima facie* case of obviousness in view of the lack of motivation to combine the referenced teachings, the rejections under Section 103(a) are improper and should be withdrawn. Favorable action upon each claim of Claims 1-25 and 30-39 is solicited.

Please continue to address all correspondence in this Application to Mr. Edgar E. Spielman, Jr. at the address of record.

Respectfully Submitted,

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**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

12-23-03  
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*Cynthia M. Farr*